

REMARKS

A. The Invention

The invention to which the Restriction Requirement is directed involves compositions comprising HLA-binding peptides having binding motifs for HLA2.1 molecules.

B. The Traversed Restriction Requirements

In the Restriction Requirement dated February 6, 1996, the Examiner required restriction to one of the following groups:

- A) a peptide of nine residues (claims 1-10), or
- B) a peptide of ten residues (claims 11-18).

The Examiner further requested election of a particular species within the elected group.

Applicants hereby elect with traverse Group A (a peptide of 9 residues) and species KMVELVHFL. However, Applicants traverse below the Restriction Requirement and the required election of species, and hereby request reconsideration of the Restriction Requirement.

Applicants submit that search and examination of the entire application can be made without serious burden to the Examiner and, therefore, the claims should be examined together. Applicants further assert that the Restriction Requirements unjustifiably place an unconscionable burden on them by forcing them to prosecute in a piecemeal fashion claims that should be examined together, rendering prosecution of their invention prohibitively expensive.

1. **Standards for restriction**

35 U.S.C. §121 provides that "[i]f two or more *independent* and *distinct* inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions." (emphasis added) Thus, restriction is appropriate only when claims meet a threshold level of distinctness and independence, and even then restriction is permissive, not mandatory.

However, even where an application encompasses distinct and independent inventions, a serious burden on the Examiner must exist to support a restriction. Specifically, "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions." Manual of Patent Examining Procedure ("MPEP") §803.

The existence of a serious burden on the Examiner may be shown if it is established that the inventions (1) have acquired separate classification, (2) have acquired separate status in the art, or (3) require a different field of research. MPEP §808.02.

2. **The suggested restriction groups have an *identical* classification, and should not be separately examined**

Under MPEP §808.02, the fact that claims have similar classification weighs against concluding that it would place a serious burden on the Examiner to examine them together. The Examiner has not asserted that the two groups of composition claims that he has identified for restriction have a separate classification; indeed, Applicants fail to see how they could possibly logically be separately classified. The fact that the claimed compositions should be identically classified strongly weighs against their being separately considered.

3. **The claimed compositions have identical status in the art**

The Examiner has not argued that the claimed compositions from one of the restriction groups has acquired a separate status in the art from the remaining group. Applicants respectfully submit that this is not the case. They cannot conceive of a reputable basis for concluding that the claims of group A have a different status in the art than those of Group B.

4. **The inventions to which the restriction groups are drawn do not require separate fields of search**

Similarly classified claims may properly be restricted if they require separate fields of search. MPEP §808.02(3) provides that "[w]here it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown..."

The Examiner has not given any reason why the examination of the restricted claims would require searching separate fields. Applicants submit that it would be extremely difficult and time consuming to deliberately frame separate prior art searches for examination of any of the restriction groups in a manner that would not yield art pertinent to the examination of the remaining groups.

5. **Separate examination would be duplicative and unduly burdensome**

Applicants respectfully submit that even if the restricted claims have acquired separate status in the art and require separate fields of search, the pending Restriction Requirements are still inappropriate. The composition claims in the pending application are all directed to peptides that bear an HLA A2.1 binding motif. Applicants strongly believe


that separate examination, as opposed to concurrent examination, would place an undue burden on the PTO's resources and on the Examiner rather than ease their burden.

CONCLUSION

In summary, Applicants believe restriction between identically classified Groups A and B and the proposed species election is unnecessary and improper. Concurrent examination of these claims will impose no undue burden upon the Examiner. Applicants, therefore, respectfully request that the above identified Restriction Requirements be withdrawn. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 543-9600.

Respectfully submitted,

By


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